

PATENT

Paper No.

File: Schoen-P1-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	:	KHODARA, Jean-Philippe, PALANI, Swaminathan, SCHOEN, Matthew B.
Serial No.	:	10/784,719
Confirmation No.	:	9452
Filed	:	February 23, 2004
For	:	SUPERSTRUCTURE POOL COMPUTER SYSTEM
Group Art Unit	:	3684
Examiner	:	MEINECKE DIAZ, Susanna M.

MS: Notice of Appeal
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR REJOINDER

SIR :

Applicant petitions from the Election/Restriction (species) Requirement issued on 04/28/2009 and traversed on 10/28/2009.

First, the Examiner has contended, at page 7 of the Office Action, that the "species are independent or distinct because claims to the different species recite mutually exclusive characteristics of such species." However, the Examiner did not establish that the contended species are indeed species.

The burden is on the PTO to establish species, and the mere above-quoted contention is not sufficient to distinguish species from dependent claims which are not species, and not sufficient to distinguish each particular specie from any other specie. The Examiner has not

met the PTO burden for a proper species requirement, and the requirement is improper.

Second, pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to “the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*”. A similar requirement is made by Rule 104(a)(2), which requires “...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has been denied this entitlement, based upon the manner in which the requirement has been set forth. In view of Sec. 132 and Rule 104, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*” and no such information has been provided. Accordingly, the requirement is improper under Sec. 132 and Rule 104.

Third, even if the claims were established as “separate and distinct,” there is “a serious burden on the Examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).” And pursuant to GUIDELINES found there, “examiners must provide reasons and/or examples to support conclusions.” The Examiner has not provided sufficient “reasons and/or examples to support conclusions” as required by the MPEP. The Examiner contends that

“There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one of the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.”

Applicant respectfully submits that this is a mere boilerplate that has not been applied so as to establish that there is any particular burden with respect to any particular specie, if indeed the Examiner has established that every one of the groups constitutes a proper specie. The above-quoted section is a PTO burden, the Examiner is required to apply, not merely copy in an

MPEP section, to each particular species.

It is not apparent from the record, nor can Applicant see, how “the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.” The Examiner’s explanation is required as to any particular species where the Examiner believes the contention to be true.

It seems that the contention of “searching different classes/subclasses” cannot be correct in that no class or subclass has been associated with the alleged species, and one might imagine that the class and subclasses would be similar and searched as a matter of course in a quality examination.

It is believed to be routine to use “different search queries” with respect dependent claims, and this alone does not establish a burden, nor does the use of different electronic resources. More so, Applicant disputes that a proper PTO prior art search for the elected specie will not include a search of the art of any other specie, and if the Examiner disagrees, then Applicant has required the Examiner’s declaration or affidavit to establish the fact. In any case, the Examiner’s evidence, declaration, or affidavit is hereby required to establish veracity of what otherwise appears to be mere contention of a serious burden, the contention having no apparent application to each of the alleged species. Further this *information* is also required pursuant to Sec. 132 and Rule 104. The requirement is therefore improper.

Fourth, MPEP Sec. 803 states “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” The MPEP also requires consideration of linking claims. In the Office Action, no consideration has been shown as to linking claims of the contended species, and further this *information* was also required pursuant to Sec. 132 and Rule 104. The requirement is therefore improper.

In sum, for the reasons set forth above, the requirement is believed to be improper.

Accordingly, Applicant respectfully requests that the claims of all groups, or any of the groups, be rejoined.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Additionally, the Examiner is invited to contact the undersigned at (312) 240-0824 if it can in any way expedite or ease the handling of this case.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



Date: May 31, 2011

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